REMARKS/ARGUMENTS

The rejections presented in the Office action dated September 12, 2005 have been considered. Claims 1-12 are pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 9-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,775,559 by Weghorst et al. (hereinafter "*Weghorst*"). The Applicants respectfully traverse the rejection in view of the present response. While not acquiescing with the particular characterizations of *Weghorst* as applied to the rejected claims, independent Claim 9 has been amended to facilitate prosecution of the application and more clearly identify differences from the cited prior art, as described more fully below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.* every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, in order to anticipate Claim 9, *Weghorst* must expressly or inherently teach every element of Claim 9, and do so *as arranged in the claim*. It is respectfully submitted that *Weghorst* does not expressly or inherently teach every element of Claim 9, as originally filed and particularly as amended.

Claim 9 includes generating means for generating a USSD message that includes data relating to parameters of the user terminal. The Office Action suggests that *Weghorst*, particularly at column 3, lines 20-27 and column 4, lines 5-10, teaches this claimed feature. The Applicants respectfully disagree. It is respectfully submitted that *Weghorst*, column 3, lines 20-27 generically indicates that a first message containing configuration settings may be transmitted, but this is not specific to using USSD. At column 4, lines 5-10, USSD is mentioned only in the context of the terminal receiving configuration messages, which can be in the form of SMS or USSD. Therefore, *Weghorst* does not teach or otherwise disclose generating a USSD message in the user terminal that includes parameters of the user terminal. Neither this nor other portions of *Weghorst* teach this recitation, and it is therefore clear that *Weghorst* does not expressly teach this element.

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If the contention in the Office Action is that *Weghorst* inherently teaches this claimed feature, then the requirements to demonstrate inherency must be shown. The Applicants respectfully submit that it has not been shown that generating a USSD message at the user terminal to provide data relating to parameters of the user terminal is inherent pursuant to M.P.E.P. § 2112, nor is it the case that inherency applies. As stated in *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted):

> To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is <u>necessarily present in the thing described in the reference</u>, and that it would be so recognized by persons of ordinary skill. Inherency, however, may <u>not be established by probabilities or possibilities</u>. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. (emphasis added)

Thus, to establish that *Weghorst* inherently teaches the generation of a USSD message at the user terminal to provide data relating to parameters of the user terminal, the Examiner must establish that is it clear that these recitations are **necessarily present** in the system of *Weghorst*, and that persons of ordinary skill would recognize that *Weghorst's* system includes this claimed feature. The Applicant respectfully submit that the expressly missing recitations are not necessarily present in *Weghorst*.

Notwithstanding the foregoing, Claim 9 has been amended to facilitate prosecution of the application. The generating means generates a USSD message that includes status information of the user terminal, and the transceiver means transmits the USSD message to the application server for enabling the application server to update the status information on the user terminal on the data relating to the parameters of the user terminal. This further distinguishes Claim 9 from *Weghorst* which describes sending parameters from the server to the user terminal and relates to remote configuration of parameters used in the user terminal by control from the server, *i.e.*, controlling the user terminal. In Claim 9, status information on the user terminal is updated to the application server, using a USSD message(s) generated via the user terminal.

For at least the foregoing reasons, it is respectfully submitted that *Weghorst* does not anticipate Claim 9. Further, Claims 10-12 are dependent on Claim 9, and include all the limitations of Claim 9 and any intervening claims, and recite additional features which further distinguish these claims from *Weghorst*. While Applicants do not acquiesce with the particular

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rejections to these dependent claims, including any assertions concerning inherency, it is believed that these rejections are moot in view of the remarks made in connection with independent Claim 9. Therefore, dependent Claims 10-12 are also not anticipated by *Weghorst*.

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weghorst* in view of U.S. Patent Publication No. 2002/00061746 to Jo et al. (hereinafter *"Jo"*). The Applicants respectfully traverse the rejection in view of the following. Independent Claims 1 and 5 have been amended to facilitate prosecution of the application. Referring first to independent Claim 1, the claimed method involves a user terminal that generates a USSD message that includes data relating to parameters of the user terminal, where the data includes status information on the user terminal, and where this USSD message is transmitted from the user terminal to an HLR of the radio system. Similarly, in Claim 5, the user terminal is configured to generate a USSD message that includes status information of the user terminal that is transmitted to the HLR.

As remarked above, the Applicants respectfully submit that *Weghorst* does not teach, nor does it suggest, generating a USSD message at the user terminal that includes status information of the terminal. While *Jo* is not cited as teaching this claimed feature, it does not remedy this deficiency of *Weghorst*. Thus, a combination of *Weghorst* and *Jo* does not teach or suggest at least the generation of a USSD message at the user terminal to provide such status information.

To establish a *prima facie* obviousness based on a combination of references, three basic criteria must be met, as is set forth in M.P.E.P., §2143. One of these criteria is that the combination of references must teach or suggest all of the claim limitations. As indicated above, the combination of *Weghorst* and *Jo* fails to teach or suggest at least the generation of a USSD message at the user terminal to provide such status information, and *prima facie* obviousness is not established for Claims 1 or 5 as amended. Claims 1 and 5 have further been amended to establish that the application server updates the status information on the user terminal. The configuration system of the combination of *Weghorst* and *Jo* does not teach or suggest the updating of status information in this manner, and for at least these reasons it is respectfully submitted that Claims 1 and 5 are not rendered obvious by the cited combination.

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Under M.P.E.P. § 2143, and in addition to showing that the cited combination teaches or suggests all the claim limitations, *prima facie* obviousness can only be established if there is some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. *Weghorst* relates to configuring a terminal from a remote location, and *Jo* relates to the usability of services of the radio system in a roaming situation. It is respectfully submitted that these references do not address a common problem or suggest any interoperability therebetween. In the Office Action, the cited motivation to combine these references is "for the purpose of increased security and protocol adaptability" (*see* Office Action, page 5, lines 4-8 and page 6, lines 17-21). It is respectfully submitted that this does not establish the requisite motivation to combine these references. The Examiner must show some objective teaching leading to the combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). It is respectfully submitted that there is no such objective teaching that leads to the combination of *Weghorst* and *Jo*, and it is respectfully submitted that aspects purportedly found in the prior art have been pieced together to arrive at the invention through impermissible hindsight. As stated by the Federal Circuit:

> Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999) (*citing Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). In the present case it is respectfully submitted that the references themselves do not provide the suggestion or motivation to combine these references. Further, the nature of the problems being solved in *Weghorst* and *Jo* are entirely different, and the Applicants contend that one of ordinary skill in the art would not, as suggested in the Office Action, have been motivated to modify the remote configuration system of *Weghorst* with the roaming disclosure of *Jo*.

Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art

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references be shown, and that this <u>evidence be "clear and particular.</u>" *Id* (emphasis added). The Applicants contend that the proffered rationale of "increased security and protocol adaptability" does not rise to the clear and particular evidence required to establish the proper motivation to combine references. For this additional reason, the Applicants respectfully submit that *prima facie* obviousness is not established for the obviousness rejection based on *Weghorst* and *Jo*.

Dependent Claims 2-4 and 6-8 are respectively dependent from independent Claims 1 and 5, and also stand rejected under 35 U.S.C. §103(a) by the combination of *Weghorst* and *Jo*. While Applicants do not acquiesce with any particular rejections to these dependent claims, including any assertions concerning common knowledge, obvious design choice and/or what may be otherwise well-known in the art, it is believed that these rejections are moot in view of the amendments and remarks made in connection with independent Claims 1 and 5. These dependent claims include all of the limitations of their respective base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." M.P.E.P. §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-4 and 6-8 are also allowable over the combination of *Weghorst* and *Jo*.

If the Examiner finds it helpful, the undersigned attorney of record invites the Examiner to contact him at 952.854.2700 (ext. 11) to discuss any issues related to this case.

Respectfully submitted,

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